APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/506,945	02/18/2000	David P. Ress	10610RNUS02U;1273/19	9089

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EXAMINER
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ART UNIT	PAPER NUMBER
2663	

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _03 July 2003_ .

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under _Ex parte Quayle_, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-33_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-21 and 27-33_ is/are rejected.

7) ☒ Claim(s) _22-26_ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)	4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) ☐ Notice of Informal Patent Application (PTO-152)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) ☐ Other: .

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments with respect to claims 1-9, 11-15, 20, 21, and 27-33 have been

considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

3..   Claims 1, 2, 4, 8-11, 13, 19, and 20 are rejected under 35 U.S.C. 102(e) as being

anticipated by U.S. Patent No. 6,584,093 to Salama et al.

Regarding to claim 1, Salama et al disclose a system in figure 17 having the GW1

receives the call from PX2 in H.323 protocol, translates the call form H.323 to SIP, and further

forwards the call to PX3 using SIP (Col. 12, line 49-col. 13, line 40). For performing these

operations, it is inherent that the GW1 comprises:

A means (first protocol agent) for communicating with PX2 (first IP telephony device)

using H.323 protocol (first IP telephony protocol);

A means (second protocol agent) for communicating with the PX3 (second IP telephony

device) using SIP (second telephony protocol);

A translation means for performing translation between H.323 protocol and SIP. It is

also inherent that the translation is performed based on a set of predetermined rules (third

protocol), which determines which feature in H.323 protocol equivalent to which feature in SIP.

Regarding to claim 2, for performing translation, it is inherent that the translation means

must understand both H.323 protocol and SIP. Therefore, the part of the translation means that

understands the H.323 protocol is considered the claimed first interworking agent component

and the part of the translation means that understands the SIP is considered the claimed second

interworking agent component.

Regarding to claims 4, and 13, Salama et al disclose one protocol is H.323 and the other

is SIP.

Regarding to claim 8, from figure 17, Salama et al disclose the H.232 part (first

interworking agent component) performs originating call haft function, and SIP part (second

interworking agent component) performs terminating haft functions.

Regarding to claim 9, the prefix 408* is the connection information parameter data

structure.

Regarding to claims 10, and 19, the prefix 408* is the called number originated from

PSTN, therefore, it is a DTMF.

Regarding to claims 11, and 20, Salama et al disclose the call first routed from the PX1 to

the PX2 before forwarding to the GW1. Therefore,

The call received from the PX1 (first telephony device) by the PX2 is considered

equivalent to the claimed first message formatted in first IP telephony protocol;

The call received at the GW1 is considered equivalent to the claimed second message

generated in response to receiving the first message.

The call received at the PX3 is considered equivalent to the claimed third message.

Furthermore, the prefix 408* is considered equivalent to the claimed media stream

management information.

4.   Claims 1, and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by 'An

Architecture for Residential Internet Telephony Service' written by Huitema et al.

Huitema et al disclose in figure 3 a call agent performing:

Communicating with the RGW using MGCP;

Communicating with the TGW using MGCP;

Performing communicating between the RRW, and TGW.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   Claims 5, 7, 14, 21, 27-30, 32, and 33 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Salama et al.

Regarding to claims 5, and 14, Salama et al fail to disclose in figure 17 that one of the IP

telephony protocol is Q.931. However, Salama et al disclosed in figure 14 that an AS, which

does not register with a GK, (a telephony device) uses Q.931 to communicate with next AS

down the road. A skilled artisan would have motivated to modify the GW1 in Salama et al so

that in can also perform translation between Q.931 and H.323 in order support connect IP

telephony call when one of AS does not register with a GK. Therefore, it would have been

obvious to a person having ordinary skill in the art by the time the invention was made to made

one of the IP telephony protocol is Q.931 in the system of figure 17.

Regarding to claim 21, Salama et al fail to disclose in figure 17 to determine whether to

translate the call form H.323 to SIP, and transmitting the call without performing translation.

However, Salama et al disclose in figure 18 that an AS in some cases connects to

different ASes wherein each AS supports different IP telephony protocol. Therefore, a skilled

artisan would have been motivated to modify the AS2 in figure 17 so that prior to perform the

translation, determines whether the AS2 connects to a AS that can support H.323 and if that is

the case forwarding the call through that path in order to avoid protocol differences. Therefore,

it would have been obvious to a person having ordinary skill in the art by the time the invention

was made to determine whether to translate the call form H.323 to SIP, and transmitting the call

without performing translation.

Regarding to claim 7, further to the rejection of claim 21, Salama et al disclose in figure

18 the first and second protocols are H.323.

Regarding to claims 27, 28, and 32, further to the rejection of claims 1, 2, and 5

respectively, Salama et al, in figure 17, fail to disclose translating the media capabilities

information between two protocols because Salama et al fail to disclose the call includes the

media capability information.

However, Salama et al disclose in figure 2 that exchanging media capability information

is a known feature in VoIP. Therefore, a skilled artisan would have been motivated to modify

the call in figure 17 so that it includes media capability information in order to enforce QoS as

taught by Salama et al (Col. 3, lines 15-20). Therefore, it would have been obvious to a person

having ordinary skill in the art by the time the invention was made to translate the media

capabilities information between two protocols.

Salama et al also fail to disclose a computer program product stored in a computer

readable medium for performing these steps.

Since it is well known in the art that a procedure can be implemented by software,

hardware or the combination of both. Software is suitable for a system that requires frequent

modification because the only change that must be done is rewriting the program. A person of

ordinary skill in the art would have been motivated to implement a system by software in order

to employ its easy-to-modify feature. Therefore, it would have been obvious to a person having

ordinary skill in the art by the time the invention was made to write a computer program product

and store the program in a computer readable medium for performing these steps.

Regarding to claim 29, it is inherent the translation procedure is reverse in the opposite

direction.

Regarding to claim 30, the prefix 408* is considered equivalent to the claimed 'media

stream management information'.

Regarding to claim 33, Salama et al disclose one protocol is H.323 and the other is SIP.

7.   Claims 3, 12, 15-18, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Salama et al as applied to claim 1 above, and further in view of 'An Architecture for

Residential Internet Telephony Service' written by Huitema et al.

Regarding to claim 3, 12, and 15, Salama et al fail to disclose one of the IP telephony

protocol is MGCP. Huitema et al disclose in figure 5 a call agent for translating between MGCP

and H.323 protocol. A skilled artisan would have motivated to modify the GW1 in Salama et al

so that in can also perform translation between MGCP and H.323 in order to connect IP

telephony call between two IP telephony networks that use different protocols. Therefore, it

would have been obvious to a person having ordinary skill in the art by the time the invention

was made to made one of the IP telephony protocol is MGCP in Salama et al system.

Regarding to claim 16, further to the rejection of claim 15 above, Salama et al fail to

disclose explicitly in figure 17 the call contains a fast start parameter and performing translation

the fast parameter between two protocols.

However, Salama et al disclose that each protocol has a different priority in connecting a

call (Col. 19, line 58-col. 20, line 24). Therefore, a skilled artisan would have been motivated to

modify the call in figure 17 so that it includes a priority information (fast start parameter) so that

the system can connect a call based on protocol priority as taught by Salama et al. Therefore, it

would have been obvious to a person having ordinary in the art by the time the invention was

made to include a fast start parameter in the call and perform translation the fast parameter

between two protocols.

Regarding to claim 17, and 18, Salama et al fail to disclose the call includes

HOLD/RETRIEVE message and translating the HOLD/RETRIEVE message from the first

protocol to the third protocol. Huitema et al disclose MGCP can support Holding and retrieving

information (Pages 52, and 54). A skilled artisan would have been motivated to modify the call

in figure 17 so that it also includes holding and retrieving information in order to provide users

similar services supported by PSTN as taught by Huitema et al. Therefore, it would have been obvious to a person having ordinary skill in the art by the time the invention was made to include the HOLL/RETRIEVE message and translate the HOLD/RETRIEVE message from the first protocol to the third protocol in figure 17.

Regarding to claim 31, Salama et al and Huitema et al fail to disclose a computer program product stored in a computer readable medium for performing these steps.

Since it is well known in the art that a procedure can be implemented by software, hardware or the combination of both. Software is suitable for a system that requires frequent modification because the only change that must be done is rewriting the program. A person of ordinary skill in the art would have been motivated to implement a system by software in order to employ its easy-to-modify feature. Therefore, it would have been obvious to a person having ordinary skill in the art by the time the invention was made to write a computer program product and store the program in a computer readable medium for performing these steps.

Allowable Subject Matter

8.   Claims 22-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhat Do whose telephone number is (703) 305-5743. The examiner can normally be reached on 8:30 AM - 5:30 PM Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Chau Nguyen can be reached on (703) 308-5340. The fax phone number for the

organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is 703-305-3900.

Nhat Do
Examiner
Art Unit 2663

NP

September 16, 2003

MELVIN MARCELO
PRIMARY EXAMINER